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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,616	07/11/2003	Bore G. Raju	PC19348A	2915
28880 PFIZER INC. PATENT DEPARTMENT, MS8260-1611 GROTON, CT 06340	7550 01/02/2009		<div>EXAMINER</div> <div>LOEWE, SUN JAE Y</div>	
			<div>ART UNIT</div> <div>1626</div>	<div>PAPER NUMBER</div>
			<div>NOTIFICATION DATE</div> <div>01/02/2009</div>	<div>DELIVERY MODE</div> <div>ELECTRONIC</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

-IPGSGro@pfizer.com

### Office Action Summary

**Application No.**

10/617,616

**Applicant(s)**

RAJU ET AL.

**Examiner**

SUN JAE Y. LOEWE

**Art Unit**

1626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7, 8 and 20-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 9-11, 14-19 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9-15-2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-31 are pending in the instant application. Claims 3-5, 7, 8 and 20-30 remain withdrawn from further consideration.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on September 15, 2008 was in compliance with the provisions of 37 CFR 1.97 and 1.98. The IDS was considered. A signed copy of form 1449 is enclosed herewith.

***Response to Amendment***

3. The amendments and remarks have been fully considered. The objections to claims (Section 8, 9 of previous office action) have been obviated and are thus hereby withdrawn. The remarks are not persuasive in overcoming the 35 USC 112 1<sup>st</sup> paragraph rejections which are maintained and hereby made FINAL. See responses to Applicant's remarks below.

***Claim Objections***

4. Claims 1, 2, 5, 6, 9-11, 13-19 and 31 remain objected to for containing non-elected subject matter. The non-elected subject matter consists of the claimed compounds that are not the elected species. Applicant will be entitled to rejoinder and consideration of non-elected species upon allowability of the generic claims.

***Claim Rejections - 35 USC § 112***

5. Below are responses to Applicant's remarks:

Most  
importance, the specification as filed shows 101 examples including structures of  
representative compounds and description of their preparation that exemplify the pending  
“independent claims.”

\*\*\*\*\*

The Office, however, indicates that Applicants' claims should be limited to the “the  
compounds reduced to practice”

\*\*\*\*\*

However, Applicants again are not required to provide a structure activity  
analysis to possess written description for the pending claims. Applicants have disclosed  
numerous specific examples of compounds within the scope of the claims and have provided  
information about the activity of the claimed compounds. ”

Applicant's remarks have been fully considered, however, they are not found to be persuasive. It is maintained that the scope of species represented by the disclosure does not commensurate with the scope of the genus claimed. One of ordinary skill would not be able to extrapolate the operability of all species claimed from those disclosed. Applicant is respectfully referred to MPEP 2163, excerpts below.

A "representative number of species" means that the species which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]." See *Enzo Biochem*, 323 F.3d at 966, 63 USPQ2d at 1615; *Noelle v. Lederman*, 355 F.3d 1343, 1350, 69 USPQ2d 1508, 1514 (Fed. Cir. 2004) (Fed. Cir. 2004) ("[A] patentee of a biotechnological invention cannot necessarily claim a genus after only describing a limited number of species because there may be unpredictability in the results obtained from species other than those specifically enumerated."). "A patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when ... the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed."

Applicants have provided detailed synthetic schemes on pages 27, 28, 30, 32, 35, 37, and 40 that teach one of ordinary skill in the art how to make the claimed compounds of the present invention.

.....

Applicants respectfully submit that one of ordinary skill in the art would be capable of making applicants' claimed compounds different from those specifically described. "

Applicant's arguments are noted, however, they are not persuasive as the 35 USC 112 rejection was based on how to use, rather than how to make.

### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Sun Jae Y. Loewe/  
12-19-2008